

REMARKS

Claims 1, 2, 4 and 27-29 are pending in this application. No claims have been amended, canceled or added. Thus, claims 1, 2, 4 and 27-29 remain subject to examination.

Interview Summary:

Applicant gratefully acknowledges the courtesy extended by the Examiner and her supervisor during the telephonic interview of 9 December 2003. No exhibits were shown and no demonstrations were conducted. U.S. patents 6,189,189 (Morin et al.) and 3,784,998 (Jones, Sr.) were discussed. The interview was directed to independent claim 1 from which all other claims depend. No proposed amendments were discussed.

As regards the 112 rejection, the attorney for Applicant directed the Examiner's attention to FIG. 2 of the drawings which illustrates the boundary edge extending in substantially continuous unbroken relation around the interior.

As regards the art rejections, the Examiner argued that Morin et al. or Jones Sr. could be modified to meet the claim limitations. The attorney for Applicant noted the outstanding art rejections were all single reference obviousness rejections and that there appeared to be no teaching or suggestion for modifying the individual cited references in the manner proposed and that the necessary modifications would be detrimental to the performance of the articles being modified and/or contrary to the express teachings of those references. Thus, a *prima facie* case of obviousness had not been established. The Examiner indicated that the claims might still be rejected on the combination of Morin et al. and Jones Sr. The attorney for Applicant pointed out that this would be a new ground for rejection which had not been previously presented. No agreement was reached on the claim rejections.

Formal Rejections:

Claim 1 stands rejected under 35 U.S.C. 112, first paragraph. In particular, the Office Action takes the position that there appears to be no support for the recital of an edge boundary

extending in substantially continuous unbroken relation. Applicant notes that such a configuration is shown in FIGS. 2, 4, 8B and 9 of the specification as originally filed. Thus, reconsideration and withdrawal of the outstanding 112 rejection is respectfully requested.

Obviousness Rejections:

In the Office Action claims 1, 2, 28 and 29 stand rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent 3,784,998 to Jones Sr.. Continued rejection on this basis is respectfully traversed and reconsideration is requested at this time.

The Office Action admits that Jones Sr. fails to disclose a hexagonal edge boundary extending in substantially continuous unbroken relation around the interior portion. In order to address this deficiency in the teachings of the cited reference the Office Action takes the position that the slits in the pad of Jones Sr. are present in order to make the handle of the applicator and that one of ordinary skill in the art would recognize that the handle is an unnecessary addition which may be removed, thereby also removing the presence of the slits.

Applicant notes that the Office Action appears to justify the proposed modification solely on the grounds that it would be within the capability of one of skill in the art. That is, the Office Action offers no reason as to why one would make the proposed modification. Applicant respectfully submits that a rejection which is premised on a complete redesign of the article in the cited art with no identified motivation for making the modification fails to satisfy the standards for establishing a proper *prima facie* case of obviousness. Thus, it is submitted that the outstanding obviousness rejection based on Jones Sr. should not be maintained.

It is fundamental that the prior art must suggest the desirability of the claimed invention. Sec. MPEP §2143.01. In this regard the MPEP clearly indicates that the fact that references can be modified to reach the claimed invention does not render the modification obvious unless the prior art also suggests the desirability of the modification. Importantly for the present case, the MPEP also makes it quite clear that reliance purely on the fact that the proposed modification

would be "well within the ordinary skill in the art" is not sufficient to establish the requisite *prima facie* case of obviousness.

Applicant wishes to note that it is well established that a proposed modification cannot render the prior art unsatisfactory for its intended purpose. Moreover, if the proposed modification would change the principle of operation of the prior art invention being modified then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. See, MPEP § 2143.01. In this regard Applicant notes that if the applicator of Jones Sr. were modified in the manner proposed by the Office Action, the discrete applicator leaves (19) would not be formed within the stacked layers. This would greatly reduce the effective surface area for agent application. In addition, the proposed elimination of the handle would force the user to grasp the body of the applicator which will be saturated with the agent to be applied such as shoe polish, soap or the like. It is respectfully submitted that such a construction would be highly undesirable thereby weighing against any motivation for making the proposed modification. Of course, absent an appropriate modification for making a proposed modification a *prima facie* case of obviousness cannot be established.

Claims 1, 2, 4, 27 and 28 stand rejected under 35 U.S.C. 103(a) as being obvious over US Patent 6,189,189 to Morin et al.. As understood, the rejection is grounded on the fact that Morin et al. states that the low particulate wiper may be of any geometric shape. The Office Action then takes the position that it would have been obvious to use the claimed hexagonal shape based on the motivation to have a geometric shape that appealed to the user. Continued rejection on this basis is respectfully traversed and reconsideration is requested at this time.

In order to support an obviousness rejection the references must be considered as a whole - including portions that lead away from the claimed invention. The prior art must suggest the desirability and thus the obviousness of making the required alteration. Moreover, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

It is respectfully submitted that the Office Action's reliance on the generalized statement in Morin that any geometric shape may be used, represents the application of an impermissible "obvious to try" standard. As explained at MPEP §2145, "obvious to try" is not an appropriate standard in situations wherein the proposition is that it would have been obvious to try numerous possible choices with no guidance from the art until arriving at the claimed invention. This appears to be precisely the situation in the present case. In particular, Morin leaves open the possibility of using any geometry thereby providing an infinite set of choices without providing any guidance as to the fact that geometry may be important let alone any guidance as to how to select an appropriate geometry.

The Office Action takes the position that one of skill in the art would have recognized the gained advantages of a hexagonal shape since one of ordinary skill could use known general geometry formulas to compare surface areas to edge perimeters so as to determine the optimum shape to have a greater surface area with less contamination. However, this position presupposes that the significance of this relationship was understood. Applicant respectfully points out that this position is contradicted by Morin itself which states that the wipers are preferably square. Thus, the statement in Morin that square wipers are preferred reflects the fact that the potential benefits of non-square geometries were unrecognized. Accordingly, there would have been no motivation for engaging in the analysis proposed by the Office Action.

MPEP §2141.02 makes it clear that a patentable invention may reside in the identification of the source of a problem even if the remedy is obvious once the source of the problem is identified. This is part of the subject matter as a whole which should always be considered in determining obviousness. As best understood, there is nothing in the art of record to suggest that there was any appreciation for the fact that increasing edge perimeter relative to interior surface area may lead to increased particle generation. To the contrary, the statement in Morin et al. that any shape may be used demonstrates that this concept was apparently not given attention.

Finally, as regards the position in the Office Action that a particular shape carries no patentable weight, Applicant notes that the cases cited relate to aesthetic design choices which

one of skill in the art would find obvious. These cases do not address situations in which the choice is made to address a previously unrecognized source of a problem as in the present case. At most, it can be argued that one might have chosen the claimed construction. However, absent an understanding of the problem being solved (which does not appear to have been present) one might just have readily chosen any one of an infinite number of other geometries which do not address the problem. As explained above, this represents a classic impermissible "obvious to try" basis for rejection.

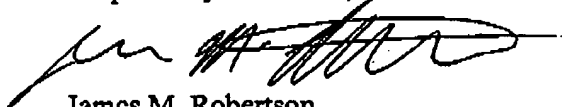
Applicant also respectfully notes that any choice other than square requires one to ignore the specific recommendations in Morin et al.. In light of the apparent mindset prior to the present invention that square geometries were most desirable, it is respectfully submitted that the present invention may be reached only by application of an impermissible 'obvious to try' standard or by hindsight reconstruction using the teachings of the present application as a guide. Therefore, it is requested that all outstanding rejections be reconsidered and withdrawn at this time.

CONCLUSION:

For the reasons set forth above, it is respectfully submitted that all claims stand in condition for allowance. In the event that any issue remains unresolved, the Examiner is encouraged to contact the undersigned attorney in the hope that such issue may be resolved in an expedient and satisfactory manner.

A petition for a one (3) month extension of time is provided herewith. To any extent that an additional extension is required, a petition for such an extension is hereby made and authorization is provided to deduct any fee necessary for the acceptance of this paper from Deposit Account 50-1424.

Respectfully submitted,



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